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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,500	04/30/2001	William Grey	I01.019	2096

28062 7590 03/21/2003

BUCKLEY, MASCHOFF, TALWALKAR, & ALLISON
5 ELM STREET
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EXAMINER

TREMBLAY, MARK STEPHEN

ART UNIT PAPER NUMBER

2827

DATE MAILED: 03/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/845,500

Applicant(s)

GREY ET AL.

Examiner

Mark Tremblay

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Serial Number: 09/845,500

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Applicant: Grey et al.

Filing date: 4/30/2001

Claim Rejections - 35 USC § 112

5 Claims 5, 8-13, 17, 21-23 and 28 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

 Re claims 5, 8-13, 17, 21-23 and 28 the claims are indefinite because they recite numerous non-equivalent alternatives.

10 ***Claim Rejections - 35 USC § 102***

 The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

 A person shall be entitled to a patent unless --

15 (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

 Claims 1, 3, 8, and 27-28 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent #5,401,96 to Fisun et al. ("Fisun" hereinafter). Fisun discloses an item, comprising:
 an item surface 15; and

20 a plurality of machine-readable item codes 5, 6 printed on the item surface, at least one of the item codes 6 being associated with the item and being substantially invisible to a human.

25 Claims 1, 4, 8-15, 23-25, and 27-28 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent # 6,039,257 to Berson et al. ("Berson" hereinafter). Berson discloses an item, comprising:

 an item surface 12; and

30 a plurality of machine-readable item codes 18, 31 printed on the item surface, at least one of the item codes 31 being associated with the item and being substantially invisible to a human.

Re claim 14, any two areas can be considered distinct. For example, in this sentence the letters "x" and "a" in the second word are printed in distinct areas.

5 Claims 16-19 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by U.S. Patent #5,498,305 to Mailloux.

Claims 16-19 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by U.S. Patent #5,522,623 to Soules et al.

10 ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

15 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20 This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

25
30 Claims 2 and 5-7 are rejected under 35 U.S.C. §102 as anticipated by, or alternatively, under 35 U.S.C. § 103 as being unpatentable over Berson in view of the skilled artisan's knowledge about PDF 417, as exemplified in "The Bar Code Book" by Roger C. Palmer ("Palmer" hereinafter). Berson discloses the features of the invention as described above, but fails to teach much about PDF 417. PDF is a standard two dimensional bar code, invented by Symbol Technologies more than a decade ago, and well known in the art. Palmer provides

textbook information about PDF 417. Since PDF 417 is a specific standard, all standard information about PDF 417 is either incorporated by reference and/or inherent in Berson, in which case 35 U.S.C. §102 applies, or alternatively obvious in view of the standard information about PDF 417. Berson provides information about PDF 417. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the teachings of Berson which mention PDF 417, with standard detailed information about PDF 417 because the skilled artisan would be motivated by the reference to PDF 417 to seek information about the PDF 417, and combine it with Berson.

Re claim 2, it is clear from claims 5-6 that Applicant has an expansive definition of "item code". As such, each of the codes in the PDF 417 can be considered alone or in combination with other codes. Since the claim is written as "comprising", it matters not that there is visible information in the exemplary embodiment of Berson, when in fact, Berson comprises a plurality of item codes 31, all of which are invisible.

Re claims 5-6, it is clear that PDF 417 may contain numerous data items in different rows. These numerous items can be anything the artisan wants, including the numerous items taught in Berson. The PDF 417 code contains metadata, or data about the data, telling the reader how to assemble the data, and decode it. It includes start codes, stop codes, left row indicators, right row indicators, Global Label identifiers, error detection and correction codes, and characters which define the total number of characters in the data region. As a whole, this constitutes metadata, which is used to tell the reader how to find where the data is positioned, how much data there is, etc.

Claims 20-22, 25-26 are rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent #5,489,158 to Wang et al. ("Wang" hereinafter) in view of Berson. Wang teaches the basic features of the claimed invention, but does not teach that the code can be invisible. Berson teaches the printing of invisible PDF 417 for security. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to print the PDF 417 taught by Wang using invisible ink as taught by Berson, because this would increase the security of the documents contemplated by Wang.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U. S. Patent #6,138,913 to Cyr et al. and U. S. Patent #5,693,693 to Auslander et al. is cited for showing another invisible coding system for ID cards.

U. S. Patent #5,532,104 to Goto is cited for showing another invisible information recording system which may be applied to cards or other articles.

U. S. Patent #3,919,447 to Kilmer, Jr. et al. is cited for showing background on invisible inks used on ID cards.

Voice

Inquiries for the Examiner should be directed to Mark Tremblay at (703) 305-5176. The Examiner's regular office hours are 10:30 am to 7:00 pm EST Monday to Friday. Voice mail is available. If Applicant has trouble contacting the Examiner, the Supervisory Patent Examiner, Michael Lee, can be reached on (703) 305-3503. Technical questions and comments concerning PTO procedures may be directed to the Patent Assistance Center hotline at 1-800-786-9199 or (703) 308-4357.


MARK TREMBLAY
PRIMARY EXAMINER

March 18, 2003